

PATENT
Atty. Dkt. No. ROC920010264US1
MPS Ref. No.: IBMK10264

REMARKS

This is intended as a full and complete response to the Office Action dated December 15, 2004, having a shortened statutory period for response set to expire on March 15, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-36 are pending in the application. Claims 1-31 and 33-36 remain pending following entry of this response. Claims 1, 11, 22, 27-29, 33, 34 and 36 have been amended. Claim 32 has been cancelled. Applicant submits that the amendments do not introduce new matter.

Claim Rejections - 35 USC § 103

Claims 1-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Kenney et al.* (U.S. Patent 6,748,471, hereinafter *Kenney*) in view of *Irons* (U.S. Patent 6,192,165). Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

The *Kenney* and *Irons* references do not teach or suggest all claim limitations. Specifically, neither reference teaches or suggests automatically affixing labels to printed documents. The Examiner argues that automatically affixing labels is taught by *Irons* at column 7, lines 65-67. Respectfully, the Examiner errs. *Irons* teaches that the labels are applied by a user, not by an automated process performed without user intervention. For example, *Irons* provides a storage location for paper-based documents "after they have been indexed and labeled by the user." Column 7, lines 2-5. Manual application of the labels is further confirmed by *Irons*' description of two embodiments of the desktop labeling mechanism 202 with reference to Figures 3 and

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3a. Specifically, regarding the first embodiment shown in Figure 3, *Irons* states that "labels are then transferred by hand to a paper-based document..." Column 8, lines 54-55 (emphasis added). Regarding the second embodiment shown in Figure 3a, *Irons* states that "[t]he user can insert the paper into opening 310 and desktop labeling mechanism 202 will apply the label directly to the paper." Column 8, lines 63-65 (emphasis added). Accordingly, the Examiner has not established a *prima facie* case of obviousness because the prior art references do not teach or suggest all the claim limitations. Therefore, Applicant respectfully requests that the rejection be withdrawn and the claims be allowed.

Further, neither reference teaches or suggests affixing a label that contains identification information for respective print jobs in order to distinguish separate print jobs. *Irons* is in no way directed to distinguishing between print jobs. In fact, *Irons* does not even teach printing a physical document as is confirmed by the description of Figure 1 which does not include a document printer. See, Column 6, lines 34-41. It follows, that the label created by *Irons* does not include identification information for distinguishing respective print jobs as is confirmed by the description of Figure 5 showing the content of a label 500 of *Irons*. The label 500 does not include identification information for distinguishing respective print jobs. Accordingly, the Examiner has not established a *prima facie* case of obviousness because the prior art references do not teach or suggest all the claim limitations. Therefore, Applicant respectfully requests that the rejection be withdrawn and the claims be allowed.

Claim Rejections - 35 USC § 102

Claims 22-36 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Irons* (U.S. Patent 6,192,165). Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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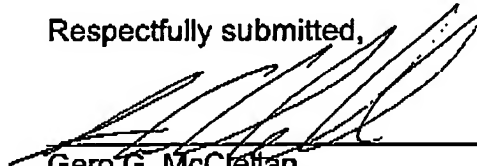
First, *Irons* does not teach a controller for controlling a label affixing device to affix a separate label to each separate printed document corresponding to a different print job so that separate printed documents can be distinguished from one another by their respective affixed labels. *Irons* is directed to digital filing of documents. *Irons* is not directed to printing, nor to any issues related to separating print jobs on a network printing device. Accordingly, the claims are not anticipated because "each and every element as set forth in the claim" is not found in *Irons*. Therefore, Applicant respectfully requests that the rejection be withdrawn and the claims be allowed.

Further, regarding claim 22, the Examiner argues "that item 202...acts as both printer and label affixing device..." Examiner's Action, Mailed Dec. 15, 2004, page 6. Respectfully, this argument is inappropriate. The item 202 does not act as the printer of the documents to which labels are affixed, as claimed. Therefore, Applicant respectfully requests that the rejection be withdrawn and the claim be allowed.

Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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